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ATTENTION: Appeal Briefs - Patents/Examiner Chuong T. Ho Group Art Unit 2664

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**Appeal Briefs - Patents/EXAMINER Chuong T. Ho**

**CERTIFICATION OF FACSIMILE TRANSMISSION**

I hereby certify that the following document(s) in re Application of Stephen Y.F. Pang, Application No. 09/353,537, filed July 14, 1999 for SYSTEM FOR POLICING JUNK E-MAIL MESSAGES is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

Document(s) Attached

1. Transmittal Form (1 pg.);
2. Fee Transmittal (in dupl.);
3. Appellants' Brief in Support of Appeal Under 37 CFR 1.192 (in trip., 33 pgs).

Number of pages being transmitted, including this page: 37

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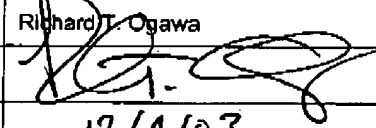
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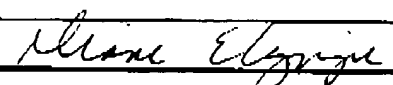
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San Francisco, CA 94111-3834  
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60093490 v1

<b>TRANSMITTAL FORM</b> (to be used for all correspondence after initial filing)	Application Number	09/353,537
	Filing Date	July 14, 1999
	First Named Inventor	Pang, Stephen Y.F.
	Art Unit	2664
	Examiner Name	Chuong T. Ho
Total Number of Pages in This Submission	Attorney Docket Number	019009-000420US

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PATENT  
Attorney Docket No.: 019009-000420US

TOWNSEND and TOWNSEND and CREW, LLP

By: Alain Elgizie

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Stephen Y.F. Pang

Application No.: 09/353,537

Filed: July 14, 1999

For: SYSTEM FOR POLICING JUNK  
E-MAIL MESSAGES

Examiner: Chuong T. Ho

Art Unit: 2664

APPELLANTS' BRIEF IN SUPPORT OF  
APPEAL UNDER 37 C.F.R. § 1.192

Commissioner for Patents  
P.O. Box 1450  
Arlington, VA 22313-1450

Sir:

This is an appeal brief in support of an appeal from the final office action  
mailed on September 18, 2003 rejecting claims 1-12 in the present application.

REAL PARTY IN INTEREST

The real party in interest is Stephen Y. Pang residing at 515 Barron Street,  
Menlo Park, California 94025.

RELATED APPEALS AND INTERFERENCES

Appellant is not aware of any related appeals or interferences.

STATUS OF CLAIMS

Claims 1-12 were pending. Claims 1-12 were rejected under 35 USC  
§103(a) as being unpatentable over McCormick et al., U.S. Patent No. 6,023,723  
("McCormick") in view of "Here is a zmail ban-spam button," 07 October 1997 ("Zmail")  
and further in view of Birrell et al., U.S. Patent No. 6,189,026, ("Birrell"). The final  
rejection of claims 1-12 mailed 5/5/2003 is the subject of the present appeal. An  
appendix to this appeal brief contains a copy of the pending claims.

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### STATUS OF AMENDMENTS

Appellant prepared and filed multiple after Final amendments under 37 C.F.R. §1.116. These amendments were based upon certain advisory actions and interviews with Examiner Ho. A summary of the amendments have been listed below.

Appellant filed an amendment after final on June 12, 2003, amending claim 1, and adding new claims 13-56. The Examiner responded with an advisory action mailed on June 30, 2003 indicating that the proposed amendment was not entered, raised new issues that would require further consideration and/or search, and presented additional claims without canceling a corresponding number of finally rejected claims.

Appellant filed an additional amendment after final on August 6, 2003, amending claim 1, and maintaining new claims 13-56. Appellant filed a supplemental amendment on August 21, 2003, amending claim 1, and maintaining new claims 13-56.

Appellant filed an amendment after final on September 2, 2003 including claims 1-12 and a terminal disclaimer. Appellant filed an amendment after final on September 9, 2003 including claims 1-12 and a terminal disclaimer.

The Examiner responded with an advisory action mailed on September 18, 2003 responsive to the amendment after final dated August 6, 2003, indicating that the proposed amendment was not entered, raised new issues that would require further consideration and/or search, raised the issue of new matter, and presented additional claims without canceling a corresponding number of finally rejected claims.

The Examiner responded with an advisory action mailed on October 7, 2003 responsive to the amendment after final dated September 2, 2003, indicating that the request for reconsideration has been considered but does not place the application in condition for allowance.

Claims 1-12 therefore remain in the form pending at the time of the final rejection.

### SUMMARY OF INVENTION

The present invention relates to a "pro-active" system that reduces the incidence of unsolicited e-mail communications.

As discussed in the Background of the Invention, unsolicited e-mail communications, SPAM, has become a burdensome nuisance for most users of e-mail messaging. To battle SPAM, various embodiments of the present invention disclose a system that allows e-mail users to request removal from a SPAM mailing lists and that enforces or polices their requests. The specification discloses embodiments enabling e-mail users to request the removal in Figs. 4 and 5. As can be seen, the request can be initiated by the identification of an e-mail message, and in one embodiment, selection of a dedicated, user-selectable button, labeled "SPAM" in Figs. 4 and 5. Other buttons or user interface indications may also be used.

In operation, one or more receivers 1000 (Fig. 10) of SPAM, selects the SPAM button and causes the removal request to be sent to the spammer 1010, step 1110 (Fig. 11). The removal request and associated data are stored in an evidentiary log, steps 1120-1130. Subsequently, in one embodiment, if the spammer 1010 ignores the removal

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request, and sends another SPAM message to the requester, step 1140, the spammer is in "violation" of the request.

In various embodiments, the system then enforces or polices the removal request after the violation is detected. In some embodiments, the notice of the violation, the evidentiary log, and the like are sent to one of a number of destinations for enforcement actions, such as to ISPs, steps 1160-1170, to a government authority, p. 20, line 8, to a "Junk E-mail Database Server," or the like. Servers that can report-out the violations are termed "policing servers." For example, the provisional application, incorporated by reference discloses:

*The method includes a step of tracking or logging violations (i.e., repeated SPAM messages to a specific receiver after the receiver requested to be removed) from a sender at a client, an ISP, or another server through a "policing" server, which is any server that can report out violations of a sender. In some embodiments, the policing server transmits a violation message to the sender, as a last threat before possible disconnection. In other embodiments, the policing server also requests the ISP, which is being used by the sender, to disconnect the sender. Still further, the policing server can transmit a violation message to enforcement agents such as governmental authorities and the like. These authorities may impose fines and other penalties to the sender. In drastic cases, the policing server transmits a "virus" or transmits large volumes of junk e-mail to the sender to tie up and/or lock up the sender. Furthermore, the policing server can send a message to a law firm that will file a legal action against the sender, as well as serve the sender via e-mail or other electronic technique. Provisional Application 60/093,120, p. 3.*

The patent specification also discussed specific types of enforcement or policing actions, such as notifying the spammer's ISP 1020 that the spammer is in violation of ISP 1020's policies, p. 19, lines 27-31. Other types of enforcement or policing actions include the demand for statutory fines or penalties from the spammer, p. 17, lines 16-19; and / or the referral of the violation to governmental authorities for enforcement, p. 20, lines 11-12, p. 22, lines 15. Additional types of enforcement or policing actions include the referral of the violation to central clearing houses, p. 21, lines 4-10, or submission of the violation to centralized black-lists, p. 22, lines 15-22.

In various embodiments of the present invention, upon the first occurrence of a SPAM message, the SPAM is reported to SPAM servers, p. 23, lines 30-34, "SPAM policing servers," p. 24, lines 1-3. For example, the specification states:

For example, as described above, reporting of SPAM may occur [on] the first "bite of the SPAM apple," not only when the spammer takes the second "bite of the SPAM apple." P. 23, lines 25-28.

In light of the above, the system is termed "proactive" because when SPAM is received, the system performs policing actions to stem the tide of SPAM - getting ISP 1020 to terminate the spammer's account, referring the incident to ISPs or Governmental bodies to legally force the spammer to stop, obtaining judgments of

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statutory or actual damages from the spammer, and the like. The policing server thus performs actions to reduce the further incidence of SPAM. In operation, for example, if ten copies of the same unwanted e-mail message are received, in various embodiments, the system performs actions to legally, monetarily, or effectively penalize the spammer for the SPAM. The embodiments are therefore "pro-active" measures, and the cost of fighting SPAM is shifted to the spammer.

The description of above is only intended to assist the Board of Appeals to understand certain aspects of the present invention and should not be unduly limiting the scope of the claims pending in the subject application.

#### ISSUE

Is the Examiner correct in rejecting claims 1-12 under 35 USC §103 as being unpatentable over McCormick and Zmail and further in view of Birrell.

#### GROUPING OF CLAIMS

For the reasons detailed below in the Argument section, the claims do not stand or fall together. Claims 1, 3, 4, 6-10 stand and fall together. Each of the claims 2, 5, 11, and 12 stands independently from claim 1 and also stands independently from each other. Accordingly, each of the claims 2, 5, 11, and 12 falls independently and separately.

#### ARGUMENT

##### Cited Prior Art

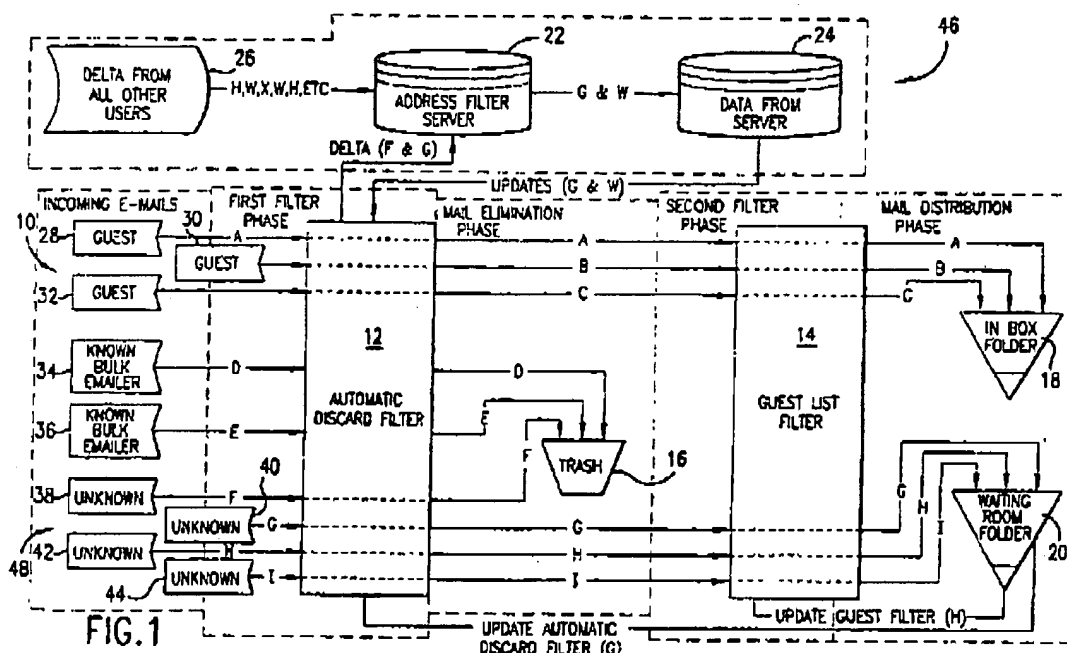
Before addressing the claims, the cited references are briefly discussed.

McCormick, as understood, discloses a "reactive" system that filters-out unwanted e-mail messages but does nothing to prevent them. More specifically, McCormick appears to disclose an e-mail system based around updatable e-mail "filter-out" and "filter-in" lists.

McCormick discloses in Fig. 1, a section 48 associated with a user's computer, and a section 46 associated with a server. As can be seen in Fig. 1, incoming e-mails are initially filtered through an "automatic discard filter" 12 provided in part by address filter server 22 in a "first filter phase." Next, the e-mails are filtered through a "guest list filter" in a "second filter phase." E-mail messages that are not on the guest list filter are moved into a waiting room folder 20.

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McCormick also discloses that users can update the automatic discard filter 12 with e-mail messages the user selects from waiting room folder 20. E-mail messages that are caught by the automatic discard filter are simply placed in trash 16.

McCormick is a "passive" system, because, it simply filters-out e-mail messages and does not describe anything about taking pro-active measures to stem the tide of unwanted e-mail messages. Thus, for example, if ten copies of the same unwanted e-mail message are received, each time, the unwanted e-mail message would be simply filtered out. Further, if 1000 copies of the same unwanted e-mail message are received, each time, the unwanted e-mail message would be simply filtered out. McCormick, therefore does not contemplate taking any "pro-active" actions to stop the spammer, and the burden of fighting SPAM remains upon the McCormick system.

Zmail, as understood, also discloses a "passive" system that provides unwanted e-mail filters but does nothing to prevent further unwanted e-mail messages. More specifically, Zmail describes an enhancement to an email system called "zmail" that gives an e-mail recipient the ability to add an e-mail sender's address to a filter.

Zmail simply filters out e-mail messages 5, no additional actions are performed to stem the tide of unwanted e-mail messages. Thus, for example, if a hundred copies of the same unwanted e-mail message are received, each time the unwanted e-mail message would be simply filtered out. As a result, the burden of fighting SPAM remains upon the Zmail system. SPAM continues and is not stopped!



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request, and sends another SPAM message to the requester, step 1140, the spammer is in "violation" of the request.

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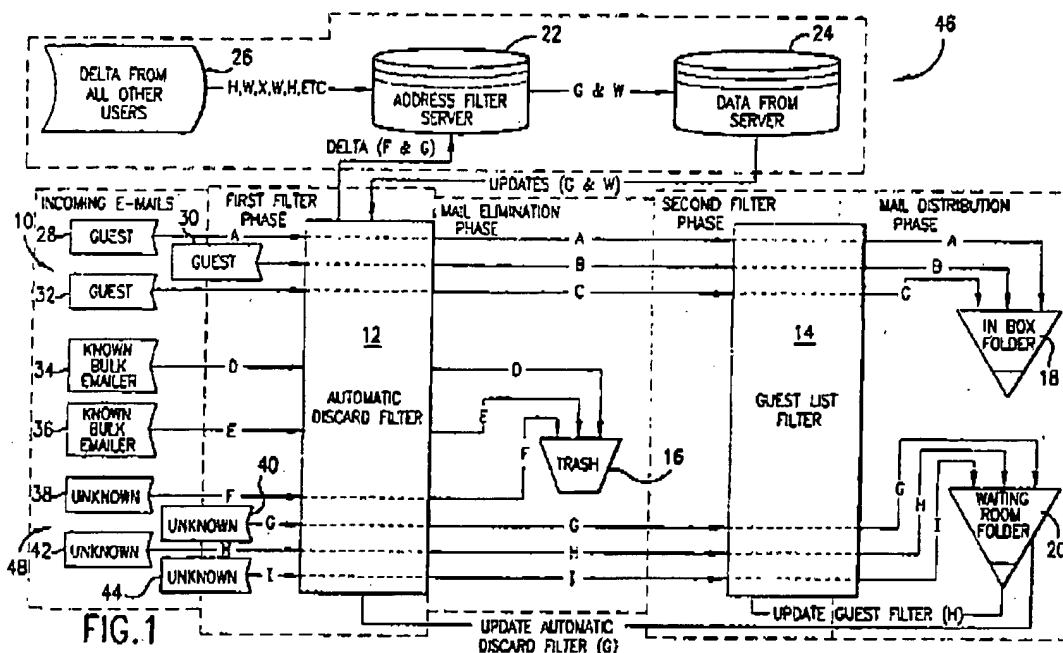
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Birrell is directed to a mail service system. Birrell provides a conventional firewall including filters. Birrell does not stop SPAM at the spamming server but merely blocks SPAM at the firewall, at best.

Further details of each of these references will be discussed throughout the present appeal brief and more particularly below.

Claims 1, 3, 4 and 6-10

It is respectfully submitted that the Examiner has failed to make a prima facie showing of obviousness regarding claims 1, 3, 4, and 6-10.

To establish prima facie obviousness, the Examiner must meet three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See Manual of Patent Examining Procedure § 2143 (2000) (collecting cases).

Regarding the third criterion, it is respectfully submitted that the Examiner has failed to show that the cited references teach or suggest all the claim elements. Appellant does not admit that the first and second criteria noted above have been satisfied. Rather, Appellant focuses on the third criterion that has clearly not been met. Claim 1 recites "a policing server coupled to each of the plurality of clients through the wide area network of computers, the policing server being adapted to receive the indication from at least one of the clients," as well as other features.

The term "policing server" is given a special meaning by the patentee:

*a policing server: a server that performs actions to reduce the incidence of further SPAM e-mail messages sent from one or more spammers.*

This definition is fully supported by the specification. As discussed above, both the provisional application and the present patent application disclose that "policing servers" perform "pro-active" actions in response to an unwanted e-mail, actions that are more than merely updating an e-mail filter. Examples of "pro-active" actions disclosed include, contacting the spammer's ISP, contacting governmental authorities to impose fines and levy penalties on the spammer, initiating private legal action against the spammer, submitting the spammer's ISP to a black list, and the like.

As discussed above, because the "policing server" is pro-active, actions are performed to stop the spammer from sending further e-mails. This is in stark contrast to McCormick or Zmail, where mere e-mail filters are set, but nothing is done to attempt to stop the spammer from sending further e-mails.

The Examiner has previously cited McCormick as disclosing a "policing server." Specifically, the Examiner cited col. 6, lines 34-38, col. 7, lines 45-48, the address filter server 22 as being a "policing server." Office Action 7/31/02, p. 2. In

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response to Applicant's arguments, the Examiner stated the Applicant's arguments were unpersuasive. Office Action 5/5/03, p. 2.

In light of the definition of the term "policing server," The Examiner's assertion is respectfully traversed. As seen in McCormick, address filter server 22 is merely a server that receives e-mail filters and re-distributes e-mail filters. Nowhere in McCormick is there any discussion about the server performing any action to reduce and preferably stop the spammer from sending further SPAM e-mail from the spammer. Instead, both McCormick and Zmail, simply "duck their heads down" and filter-out incoming e-mail, which has not been effective. Clearly, neither McCormick nor Zmail, alone or in combination show or suggest the claimed policing server coupled to each of the plurality of clients through the wide area network of computers, as recited. The present policing server is adapted to receive the indication from at least one of the clients. Additionally, such references also fail to show or suggest the further combination of the SPAM icon on the display, which is adapted to send the indication from the client to the policing server. Accordingly, claim 1 is patentable under 35 U.S.C. §103. Claims 1, 3, 4, and 6-10 are also patentable for at least these reasons and possibly others.

Claim 2

It is respectfully submitted that the Examiner has failed to make a prima facie showing of obviousness regarding claim 2. Claim 2 should at least be patentable upon claim 1. In the Office Action dated 5/5/2003, the Examiner cites Figure 1 and column 3 lines 55-60 to teach the reporting features of claim 1. Clearly, the Examiner misunderstands Figure 1 and column 3 lines 55-60, reproduced below:

*"The current filter list is maintained at the remote central location 46 as well as being periodically updated in each of the users PC systems 48. The remote location 46 would include a delta filter server 22 and download server 24 for a particular user as well as delta server filter 26 from all other users. The current filter list can be modified by the user to personally remove any addresses therefrom through various deletion techniques, thereby providing the user with a user modified discard filter."*

As can be seen above, the language noted by the Examiner has nothing to do with the invention recited by claim 2. Clearly, McCormick does not show or suggest that the policing server is adapted to report the unauthorized e-mail message. In fact, no reporting has been shown or suggested. At best, McCormick discloses updating e-mail filters, which does not actually stop or reduce spamming from the spammer. Updating filters of McCormick is not the claimed method of reporting unauthorized e-mail messages for the purpose of stopping the spammer. Accordingly, claim 2 is patentable for at least these reasons.

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Claim 5

The Examiner has also failed to make a prima facie showing of obviousness regarding claim 5. Claim 5 should be at least patentable upon claim 1 for the reasons noted. Additionally, McCormick fails to show or suggest that the policing server comprises a log of the unsolicited e-mail communication as recited by claim 5. Here, the Examiner cited Figure 3 and column 4 lines 48-56, reproduced below:

*"These new addresses are periodically and automatically transmitted to a address filter server 22 provided at the remote central location 46. Based upon numerical and temporal factors as described hereinafter, these addresses are included on the current filter list associated with the address filter server 22 stored in a filter database associated with a database server 24 in communication with the address server 22."*

Clearly, the language above has absolutely nothing to do with the policing server maintaining the log of unsolicited e-mail communications, as claimed. At best, McCormick seems to illustrate that addresses are included on the current filter list with the address filter server stored in the filter database. Logging e-mail communication in the manner claimed is not shown or suggested. Accordingly, claim 5 is patentable.

Claim 11

Additionally, it is respectfully submitted that the Examiner has failed to make a prima facie showing of obviousness regarding claim 11. Claim 11 was rejected under 35 U.S.C. §103(a) as being unpatentable over the combined system of McCormick, Zmail in view of Birrell. Appellant would now like to address the Birrell reference. As noted, a "mail service" of Birrell is not the claimed combination including the policing server. At best, Birrell suggested a conventional "firewall 130" that includes common firewall characteristics. Birrell, col. 3, lines 55-67.

The Examiner cited Birrell as teaching a governmental authority. Office Action 5/5/03, p. 6. However, upon closer inspection, the cited passage simply states that the mail system could be used by the government. There is no mention about the government performing any actions to stop SPAM. Clearly, then, the government network of Birrell is not the claimed governmental authority. Accordingly, claim 12 is patentable.

Claim 12

It is respectfully submitted that the Examiner has failed to make a prima facie showing of obviousness regarding claim 12. Claim 12 was rejected under 35 U.S.C. §103(a) as being unpatentable over the combined system of McCormick, Zmail, and Birrell. As noted, a "mail service" of Birrell et al. is not the claimed combination including the policing server. At best, Birrell suggested a conventional "firewall 130" that includes common firewall characteristics. Birrell, col. 3, lines 55-67.

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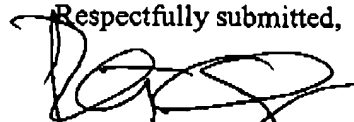
The Examiner cited Birrell as teaching an enforcement agency. Office Action 5/5/03, p. 6. However, upon closer inspection, the cited passage simply states that the firewall performs "enforces" conventional firewall policies. As is known, firewall policies simply restrict the flow of harmful information into and out of the protected system. For example, hostile users may be blocked out by a firewall policy, and internal users may be blocked from visiting adult sites, and the like by a firewall policy. Accordingly, the firewall wall is merely a "passive" system that blocks SPAM, but does nothing to reduce SPAM from spammers. In contrast, the policing server associated with the enforcement agency is not the conventional firewall mentioned by Birrell. Accordingly, claim 12 is patentable.

#### CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. This Appeal Brief is filed in triplicate.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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APPENDIX OF CLAIMS

1. (Previously amended) A system for policing an unsolicited e-mail communication comprising:
  - a plurality of clients, each coupled together using a wide area network of computers, the wide area network of computers comprising an Internet, each of the clients being adapted to send an indication of an unsolicited e-mail message through an e-mail device for a display;
  - a policing server coupled to each of the plurality of clients through the wide area network of computers, the policing server being adapted to receive the indication from at least one of the clients;
  - wherein the e-mail device comprises an SPAM icon on the display, the SPAM icon being adapted to send the indication from the client to the policing server.
2. (Previously amended) The system of claim 1 wherein the policing server is adapted to report the unauthorized e-mail message.
3. (Original) The system of claim 1 wherein the policing server is adapted to update a local e-mail filter file for the client in response to the unsolicited e-mail communication.
4. (Original) The system of claim 1 wherein each of the clients comprise an updated e-mail filter file from the policing server.
5. (Previously amended) The system of claim 1 wherein the policing server comprises a log of the unsolicited e-mail communication.
6. (Original) The system of claim 1 wherein the unsolicited e-mail message is SPAM.
7. (Original) The system of claim 1 wherein the display comprises a browser program, the browser program being coupled to the e-mail device.
8. (Original) The system of claim 1 wherein each of the plurality of clients is for a different user, where each user is capable of sending the unsolicited e-mail message to the policing server.
9. (Previously amended) The system of claim 1 wherein the policing server comprises a plurality of SPAM filters.
10. (Original) The system of claim 1 wherein each of the clients is coupled to the wide area network of computers through an internet service provider.



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11. (Previously presented) The system of claim 1 wherein the policing server is provided at a governmental authority.

12. (Previously presented) The system of claim 1 wherein the policing server is from an enforcement agency.

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